

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. SERIAL NO. 09/888,377

ART UNIT 3623
Q64738

AMENDMENTS TO THE DRAWINGS

The Examiner objects to the drawings for failing to comply with 37 C.F.R. §1.84(p)(5). Substitute drawings for Figs. 1-5 are submitted concurrently herewith.

Attachments: Replacement Sheets (5)

REMARKS

Subsequent to entry of the foregoing amendments, claims 1, 3-9, 11, 12 and 14-20 are presently pending in this application. Claims 2, 10 and 13 are hereby cancelled without prejudice and/or disclaimer.

Corrected drawing figures (Figs. 1-5) are submitted herewith, and are believed to overcome the objections in numbered paragraphs 2-4. The specification is also hereby amended to correct minor errors and improve idiomatic style.

The Examiner rejects method claims 1-17 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. This rejection is respectfully traversed. The first prong of the Examiner's analysis, i.e., whether the invention is within the "technological art," is incorrect, particularly in view of the Board's recent decision in *Ex parte Carl A. Lundgren*, Appeal No. 2003-2088 ("Our determination is that there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under §101.") As to the second prong of the Examiner's analysis, the claimed invention does produce a "useful, concrete, and tangible result." The claimed invention is not merely "nonfunctional descriptive matter." To the contrary, the claimed invention is directed to gathering business methods conceived by consumers, discussing at least one of the methods via a communication network among the conceiver, the company and, if appropriate, at least one additional

consumer selected based on certain parameters, and finally, based on that discussion, actually implementing the business method as an executable method. At least because the claimed invention results in a newly implemented business method, there is a "useful, concrete, and tangible result." Consequently, Applicant respectfully requests that the rejection under 35 U.S.C. §101 be withdrawn.

The Examiner rejects claims 1, 4, 18 and 19 under 35 U.S.C. §102(e) as being anticipated by Abelow (U.S. Patent No. 5,999,908).

The present invention relates to a method of and a system for implementing a business method that coincides with a basic business method concept of a company quickly and originally by active participation of consumers via a communication network in not only conceiving the business method, but also discussing the conceived business method.

As described in the present specification in the section entitled "2. Discussion of the Related Art," an original business method conceived by a consumer generally loses originality, because consumers do not take part in discussing the conceived method. According to the present invention, the original business method conceived by a consumer is discussed by consumers together with the company. The originality of the business method is thus maintained until it reaches an executable method. Therefore, the step of the discussion is very important for the present invention. To ensure the

success of the important discussion, the participants to the discussion are selected depending on confidentiality, potentiality and/or urgency of starting the business method. The participation of non-limiting consumers would not lead to the success. Claims 1, 9, 12 and 18 are hereby amended in order to definitely claim this point and to clearly distinguish the present invention from Abelow.

Abelow relates to improving product design by allowing consumers to participate in the product design. The system allows customers to engage in an "evolving dialog during product use" and to "assist or direct vendors in developing services offered with the product, such as training, documentation, customer support, financing, volume buying discounts, etc."

Abelow does not mention a business method, *per se*. Furthermore, the Examiner cites Abelow at col. 9, lines 47-59, and col. 13, lines 36-58, for the step of discussing the present invention. The Examiner states that "Abelow teaches the defined customers desires may be available on-line. Sellers and customers engage in an evolving dialog during product use. Customers assist defining product features, interfaces, functionalities, etc." However, the citation does not mention the discussion step of the present invention, especially "discussing via a communication network at least one of the gathered business methods, among a conceiver of the business method, the company and, if appropriate, at least one additional consumer selected depending on

confidentiality, potentiality and/or urgency of starting the business method...". In the present invention, the conceiver, company and, if appropriate, at least one additional consumer selected depending on confidentiality, potentiality and/or urgency of starting the business method discuss the business method conceived by the conceiver, in order to establish a new and executable business method. To ensure the success of the discussion, the participants to the discussion are selected depending on confidentiality, potentiality and/or urgency of starting the business method. On the other hand, Abelow mentions only the assistance of customers by providing their desires, suggestions or insights.

As described above, Applicant respectfully submits that the invention as claimed in amended claims 1 and 18 is patentably different from Abelow. The invention claimed in claims 4 and 19, which respectively depend on claims 1 and 18, is also believed to be novel and unobvious. Therefore, these claims should be allowed.

The Examiner rejects claims 2, 3, 10 and 11 under 35 U.S.C. §103(a) as being unpatentable over Abelow in view of Kozinets (Kozinets, How Online Communities are Growing in Power, Financial Times, London (UK) 9 November 1998, p. 6 [PROQUEST]).

Kozinets relates to the growth of online communities. The Examiner asserts that Kozinets teaches that online-loyal consumers evaluate quality together and negotiate standards. However, none of the cited references mentions or suggests that consumers

are selected depending on confidentiality, potentiality and/or urgency of starting the business method, and that such consumers discuss a business method conceived by a consumer with the conceiver and the company. Furthermore, Abelow does not mention the discussion step of the present invention, especially the step of the discussion among the conceiver of the business method, the company and, if appropriate, at least one additional consumer selected depending on confidentiality, potentiality and/or urgency of starting the business method, in order to implement the business method as an executable method. Therefore, the invention of claims 2, 3, 10 and 11 is believed to be patentable over the combination of Abelow and Kozinets. Claims 2 and 10 are cancelled as indicated above, and the subject matter of claims 2 and 10 are respectively incorporated into claims 1 and 9.

The Examiner rejects claims 5-9, 12-17 and 20 under 35 U.S.C. §103(a) as being unpatentable over Abelow in view of Kozinets and further in view of Harshaw (U.S. Patent No. 6,542,871).

Harshaw relates to a method for new product development and market introduction. The Examiner interprets the parties (a pool manager and a manufacturer) as business partners. However, none of the cited references teaches or suggests the specific feature of the present invention, that is, the step of the discussion, among the conceiver of the business method, the company and, if appropriate, at least one

additional consumer, selected depending on confidentiality, potentiality and/or urgency of starting the business method, in order to establish a new and executable business method. Therefore, the invention of claims 5-9, 12-17 and 20 is believed to be patentable over the combination of Abelow, Kozinets and Harshaw. Claim 13 is cancelled as indicated above, and the features therefrom are incorporated into claim 12.

In view of the preceding amendments and remarks, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned attorney at the local telephone number listed below.

The USPTO is directed and authorized to charge all required fees (except the Issue/Publication Fees) to our Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Steven M. Gruskin
Registration No. 36,818

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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